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OFFICE OF PETITIONS

PATENT
0033-0662P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: SUEMATSU, Eiji Conf.: 9172
Appl. No.: 09/588,548 Group: 2685
Filed: June 7, 2000 Examiner: Duc M. Nguyen
For: MILLIMETER WAVE BAND TRANSMITTER,
MILLIMETER WAVE BAND RECEIVER AND
MILLIMETER WAVE BAND COMMUNICATION
APPARATUS CARRYING OUT RADIO
COMMUNICATION IN MILLIMETER WAVE
BAND REGION

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Technology Center 2600

Petition under 37 C.F.R. 1.181
from Requirement of Restriction

MS PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 2, 2004

Sir:

Applicant hereby petitions to the Director of the above-identified Technical Center to request modification of the Restriction Requirement of October 22, 2003 under 37 C.F.R. 1.144. Applicant submits that the Restriction Requirement was ambiguous and thereby improper.

The Restriction Requirement of October 22, 2003 contained both a set of groups of claims (para. 1-7) and an election of species (para. 3-7). Because election of species assumes independent species, Applicant had elected a species that according to the Examiner was covered by claims 2 and 12-16 (in a Reply to Election of Species filed November 20, 2003). Applicant disagreed

with the group of claims associated with the elected species and traversed the election of species. In particular, Applicant presented an argument that the elected species was covered by claims 1, 2, and 4-16.

In response to the traversal of the election of species, the Examiner stated that the Applicant's argument was not persuasive "because the transmitter and the receiver are related as subcombinations disclosed as useable together in a single combination, whereas the receiver could be configured to respond to signals from more than one transmitter, not necessarily from a single transmitter." Thus, the Examiner had argued that the inventions are related and not mutually exclusive species, as would be required by an election of species (see M.P.E.P. 806.04(f) and M.P.E.P. 806.04(h)).

Applicant submits that the restriction requirement is ambiguous because of the confusing combination of alleged independent species on the one hand and groups allegedly directed to related inventions on the other hand. If the requirement was intended as a restriction requirement between related inventions, arguments were presented for only Group 1 (Claims 1, 4-11, 25-32), Group II (Claims 2, 12-16, 33-37), and Group III (Claims 3, 17-24, 38-45). If the requirement was intended as an election of species, then Applicant submits that the argument pertaining to the relationship between inventions does not apply to an election of species and thereby should be withdrawn. Applicant had requested that claims 1, 2 and 4-16 be grouped as a species with claim 2 being generic. The argument that different sets of these claims

constitute related subcombinations does not constitute a valid response to the Applicant's traversal.

Thus, because of the ambiguity in the present restriction requirement, Applicant respectfully requests that the restriction requirement be withdrawn and a new requirement be presented, as necessary, such that a proper group of claims can be elected and examined. As an example, Applicant requests that since claims directed to transmitter and receiver are related, the species covered by claims 1, 2, and 4-16 should be examined considering claim 2 as a generic claim. In the alternative, if the restriction requirement is considered a restriction between related inventions, then Applicant requests that the group consisting of claims 2, 12-16, and 33-37 be examined.

If necessary, the Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2448 for any additional fees required.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

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